

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TED M. McVAY, GENE F. BAXTER
and FREDERICK C. DUPRE JR.

Appeal No. 95-2022
Application No. 08/063,056¹

ON BRIEF

Before WINTERS, GARRIS and PAK, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 2, 3, 7 through 10, 12, 13, 15 and 27 through 37. Claims 17, 18, 22 through 24, 38 and 39, which are the only other claims remaining in the application, stand allowed.

¹ Application for patent filed May 19, 1993. According to appellants, this application is a continuation of Application No. 07/713,256, filed June 13, 1991, now abandoned.

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Claim 31, which is illustrative of the subject matter on appeal, reads as follows:

31. A low molecular weight lignin fraction of aqueous lignin solution useful in the preparation of lignin modified phenol-formaldehyde resins, said lignin fraction comprising molecules of a lignin solution which, upon being subjected to ultrafiltration, pass through an ultrafiltration membrane having a molecular weight cut-off of about 50,000 and are rejected by an ultrafiltration membrane having a molecular weight cut-off of about 2,000, wherein more than 60 wt[.] percent of the molecules of said lignin fraction have a molecular weight which does not exceed the molecular weight of Glucagon and more than 65 wt[.] percent of the molecules of said lignin fraction have a molecular weight which does not exceed 5,000, as determined by gel chromatography, and wherein said aqueous solution is selected from the group consisting of black liquor, lignin solution, whole bagasse lignin, and blends thereof.

The single reference relied on by the examiner:

Forss et al. (Forss)	4,105,606	Aug. 8, 1978
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The issues presented for review are: (1) whether the examiner erred in rejecting claims 2, 7 through 10, 12, 13, 15, 27 through 34, 36 and 37 under 35 U.S.C. § 102(b) as anticipated by Forss; and (2) whether the examiner erred in rejecting claims 3 and 35 under 35 U.S.C. § 103 as unpatentable over Forss. For the reasons set forth below, we affirm the rejection under 35 U.S.C. § 102(b), but reverse the rejection under 35 U.S.C. § 103.

DISCUSSION

As correctly found by the examiner, the low molecular weight lignin product defined in independent claims 31 and 32 reasonably

appears to be identical or substantially identical to the evaporated black liquor described by Forss in column 12, EXAMPLE 10. This follows for two reasons. First, the aqueous lignin solution recited in claims 31 and 32 "reads on" black liquor, whereas the source material in EXAMPLE 10 is "[b]lack liquor from a kraft cook on pine wood." Second, 67.1% (w/w) of the alkali lignins in the black liquor of EXAMPLE 10 had molecular weights not exceeding the molecular weight of Glucagon, and 74.7% (w/w) had molecular weights not exceeding 5,000 as determined by gel chromatography. Those weight percentages meet the criteria set forth in appellants' claims, namely, "more than 60 wt[.] percent of the molecules of said lignin fraction have a molecular weight which does not exceed the molecular weight of Glucagon and more than 65 wt[.] percent of the molecules of said lignin fraction have a molecular weight which does not exceed 5,000, as determined by gel chromatography."

As stated in In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977):

Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. Whether the rejection is based on "inherency" under 35 USC 102, on "prima facie obviousness" under 35 USC 103, jointly or alternatively, the burden of proof is the same, and

its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products. [Footnote and citations omitted.]

On these facts, we believe that the burden of persuasion shifted to appellants "to prove that the prior art products do not necessarily or inherently possess the characteristics of [their] claimed product." This appellants have not done. In the absence of a showing, it appears that the evaporated black liquor described by Forss, EXAMPLE 10, like the product defined in claims 31 and 32, comprises molecules which pass through an ultrafiltration membrane having a molecular weight cut-off of about 50,000 and are rejected by an ultrafiltration membrane having a molecular weight cut-off of about 2,000.

For these reasons, we find that (1) the examiner established a prima facie case of anticipation of claims 31 and 32 based on the description in Forss, EXAMPLE 10; and (2) appellants have not rebutted the prima facie case. We therefore affirm the rejection of independent claims 31 and 32 under 35 U.S.C. § 102(b) as anticipated by Forss. In so doing, we are mindful that appellants rely on data presented in their specification and in the McVay declaration, executed July 12, 1993, designed to show that their claimed product possesses unexpectedly superior results. See the Appeal Brief, section VI.C. We point out, however, that a proper rejection under 35 U.S.C. § 102 cannot be

overcome by a showing of unexpectedly superior results, which are relevant only to an obviousness rejection. In re Malagari, 499 F.2d 1297, 1302, 182 USPQ 549, 553 (CCPA 1974). Here, we find no limitation in the claims serving to distinguish appellants' product from the product described by Forss, EXAMPLE 10, and it is axiomatic that appellants cannot patent subject matter which is old.

With respect to dependent claims 2, 7 through 9, 27 through 30, 33, 34, 36 and 37, these fall together with independent claims 31 and 32 because appellants do not group or argue them separately. See the Appeal Brief, section V.

We next consider claims 10, 12, 13 and 15, which appellants argue separately (Appeal Brief, page 5, second full paragraph). We find that the examiner established a prima facie case of anticipation of these claims in view of the description in Forss, column 12, lines 37 through 53. Note particularly the disclosure of an adhesive prepared by mixing evaporated black liquor with phenolic resin, followed by the workup described in column 12, lines 42 through 53.

We are mindful that the adhesive composition of Forss, EXAMPLE 10, does not meet "requirements set by the Finnish standards" (Forss, column 14, lines 45 through 65). This does not, however, detract from the anticipatory effect of Forss with

respect to claims 10, 12, 13 and 15. Again, we find no limitation in these claims serving to distinguish appellants' product from the product described by Forss, EXAMPLE 10. Compare In re Hafner, 410 F.2d 1403, 1405, 161 USPQ 783, 785 (CCPA 1969) (§ 112 provides that the specification must enable one skilled in the art to "use" the invention, whereas § 102 makes no such requirement for an anticipatory disclosure; a disclosure lacking a teaching how to use a fully disclosed compound for a specific, substantial utility is adequate to anticipate a claim drawn to the compound).

The rejection of claims 3 and 35 under 35 U.S.C. § 103, however, stands on different footing. These claims define a low molecular weight lignin product derived from whole bagasse lignin. According to the examiner, there is not "a clear distinction" between the prior art low molecular weight lignin product derived from black liquor (Forss, EXAMPLES 10 and 11) and the claimed low molecular weight lignin product derived from whole bagasse lignin. See the Examiner's Answer, page 5. We disagree.

In our judgment, the examiner focuses too narrowly on the molecular weight limitation in claims 3 and 35 without considering the claimed subject matter as a whole, including the nature of whole bagasse lignin. In this regard, we invite

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attention to the specification, page 6, first paragraph, explaining that whole bagasse lignin is "a by-product obtained from the extraction of juice from sugar cane," i.e., it is a lignin from "sources other than wood." In contrast, Forss describes "[b]lack liquor from a kraft cook on pine wood" (column 12, EXAMPLE 10). Manifestly, all lignins are not the same. The examiner has not established that the nature of the lignin (polymerized product) in Forss, EXAMPLES 10 and 11, is the same or substantially the same compared with the nature of the lignin in claims 3 and 35. Accordingly, the examiner has not established a prima facie case of unpatentability.

The rejection of claims 3 and 35 under 35 U.S.C. § 103 as unpatentable over Forss is reversed.

In conclusion, we affirm the examiner's decision rejecting claims 2, 7 through 10, 12, 13, 15, 27 through 34, 36 and 37 under 35 U.S.C. § 102(b) as anticipated by Forss. We reverse the rejection of claims 3 and 35 under 35 U.S.C. § 103 as unpatentable over Forss.

The examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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